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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/733,033
Filing Date: December 11, 2003
Appellant(s): HOFFER ET AL.

Philip S. Lyren
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9-17-2008 appealing from the Office action mailed 4-17-2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,525,932	Ohnishi et al.	2-2003
6,285,833	Yamane	9-4-2001

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US2003/0112325A1	Boyden et al.	6-2003
6,587,151	Cipolla et al.	7-2003
5,691,766	Murata et al.	11-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 15 recites among other things: wherein the camera is in a power off state when enclosed inside the computer in the first position and automatically transitions to a power on state as the camera is ejected and physically moves from the first position inside the computer to the second position being mechanically detached from the computer. There is no support for this: especially automatically transitions to a power on state as the camera is ejected and physically moves from the first position inside the computer to the second position being mechanically detached from the computer. Once it is mechanically detached, power cannot be supplied by the power source in the computer. According to applicants specification, power is supplied to the camera from

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rechargeable batteries (paragraph: 0039) when it is mechanically detached from the computer and it is nothing to do with automatically transitioning to a power on state as claimed by the applicant.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 5-9, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnishi et al. (US PAT: 6,525,932, filed 8-16-2000, hereinafter Ohnishi) in view of Yamane (US PAT: 6,285,833).

Regarding claim 1, Ohnishi discloses a portable computer, comprising: a base portion with a keyboard (40, fig. 1, 4-8), an electronic display (12, fig. 1) connected to the base portion, and a camera (420, figs. 4-9, col. 17, line 13 – col. 18, line 12) stored in the base portion (this reads on expansion unit 200, fig. 1 and 400 figs. 6-9 which includes camera being stored in the expansion bay slot in base (20, fig. 1) of a portable computer when not in use (col. 11 lines 39-40; col. 17 lines 7-12, col. 18 lines 30-35).

Ohnishi differs from claims 1-2 in that he does not specifically teach the following: camera automatically powers on as the camera is ejected from the base portion, and camera automatically powers off when inserted into the base portion.

However, Yamane discloses camera which teaches the following: flash unit (4, figs. 1-2) automatically powers on when ejected from the base portion, flash unit

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automatically powers off when inserted into the base portion (col. 3 lines 21-41; col. 4 lines 43-56; col. 5 lines 7-34)).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ohnishi's system to provide for the following: camera automatically powers on when ejected from the base portion, and camera automatically powers off when inserted into the base portion as this arrangement would facilitate to conserve power usage by turning on power to the device on/off depending upon its usage condition as taught by Yamane.

Regarding claim 3, Ohnishi teaches the following: elongated mounting member (430, fig. 9) connected to the camera (420, col. 17 lines 30-33).

Regarding claim 4, Ohnishi teaches the following: mounting member has a cylindrical shape and provides electrical communication between the camera and the base portion (col. 17 lines 30-33).

Regarding claim 5, Ohnishi teaches the following: mounting member that mechanically and electrically couples the camera to the base portion (col. 17 lines 30-33).

Regarding claim 6, Ohnishi teaches the following: one end of the camera (420, fig. 9) is connected to a mounting member, the camera being movable about two different axes as indicated by arrows A and B in fig. 9 while connected to the mounting member (col. 17, line 66 – col. 18, line 12).

Regarding claims 7-8, Ohnishi teaches the following: base portion (20, fig. 1) comprises a cavity and camera is mounted inside the cavity (this reads on expansion

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unit 200, fig. 1 and 400 figs. 6-9 which includes camera being stored in the expansion bay slot in base (20, fig. 1) when not in use and cavity is formed in a side of the base portion (20, fig. 1; col. 11 lines 39-40; col. 17 lines 7-12, col. 18 lines 30-35).

Regarding claim 9, Ohnishi teaches the following: the camera (420, figs. 4-9) is movable between a storage portion inside the base portion (20, fig. 1, this reads on expansion unit 200, fig. 1 and 400 figs. 6-9 which includes camera being stored in the expansion bay slot in base 20, fig. 1; fig. 1; col. 11 lines 39-40; col. 17 lines 7-12, col. 18 lines 30-35) and ejected position (fig. 9) disposed outside of the base portion, the camera being mechanically connected to the portable computer while in the ejected portion, the camera is movable about two different axes as indicated by arrows A and B in fig. 9 while in the ejected position (figs. 4, 7-9).

Ohnishi differs from claims 11-12 in that he does not specifically teach the following: activating a switch located inside the computer while ejecting the camera from the computer to perform the automatically powering the camera on, activating the switch located inside the computer while inserting the camera into the computer to perform the automatically powering the camera off.

However, Yamane teaches the following: activating a switch (17, fig. 4) located inside the electronic device (1, figs. 1-2) while ejecting the flash unit (4, figs. 1-2, 4) from the electronic device to perform the automatically powering the flash unit on, activating the switch located inside the electronic device (1, figs. 1-2) while inserting the flash unit into the electronic device to perform the automatically powering the flash unit off (col. 4, line 43 – col. 5, line 34).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ohnishi's system to provide for the following: activating a switch located inside the computer while ejecting the camera from the computer to perform the automatically powering the camera on, activating the switch located inside the computer while inserting the camera into the computer to perform the automatically powering the camera off as this arrangement would facilitate to conserve power usage by turning on power to the device on/off depending upon its usage condition as taught by Yamane.

Regarding claim 13, Ohnishi further teaches the following: inserting the camera (420, figs. 6-9) into a cavity in the computer (100, figs. 6-8) so an outer surface of the camera forms an exterior surface of the computer (this reads on expansion unit 200, fig. 1 and 400 figs. 6-9 which includes camera being stored in the expansion bay slot in base (20, fig. 1) when not in use, col. 11 lines 39-40; col. 17 lines 7-12, col. 18 lines 30-35).

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnishi in view of Yamane as applied to claims 1, 9 above, and further in view of Boyden et al. (US 2003/0112325 A1, hereinafter Boyden).

The combination differs from claim 14 in that it does not teach the following: removing the camera from mechanical attachment to the computer, and transmitting wireless signals from the camera to the computer.

However, Boyden discloses camera positioning system which teaches the following: wireless transmitter (440, fig. 4) wirelessly transmitting camera signals to a wireless receiver (432) for further use (paragraph: 0079).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: removing the camera from mechanical attachment to the computer, and transmitting wireless signals from the camera to the computer as this arrangement would provide one of the methods, among many possible methods, for transmitting signals between the devices as taught by Boyden.

6. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cipolla et al. (US PAT: 6,587,151, hereinafter Cipolla) in view of Murata et al. (US PAT: 5,691,766, hereinafter Murata).

Regarding claim 15, Cipolla discloses video conference system (col. 1 lines 34-38), comprising: a computer (11, fig. 9), and a camera movable between a first position (stored position, fig. 10) and second position (usable position, fig. 9), wherein the camera is enclosed in the computer in the first position (fig. 10) and is ejected to be mechanically detached from the computer in the second position (fig. 9), the camera being electrically coupled to the computer in the second position (fig. 9; col. 5, lines 49-66; col. 6 lines 11-50)

Cipolla differs from claimed invention in that although it would be inherent to keep the camera in power off state when in stored position as shown in fig. 10 in order not to waste electrical power and turn on power to camera when it is removed from the stored

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state to use state when it is mechanically detached as shown in fig. 9, he does not specifically teach: camera is in a power-off state when enclosed in a computer in the first position and automatically transitions to a power on state as the camera is ejected and physically moves from the first position in the computer to the second position.

However, Murata teaches the following: camera light is in a power-off state when enclosed in a camera device in the first position and automatically transitions to a power on state as the camera light is ejected from the stowed position (fig. 9, col. 4 lines 25-38).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Cipolla's system to provide for the following: camera is in a power-off state when enclosed in a computer in the first position and automatically transitions to a power on state as the camera is ejected and physically moves from the first position in the computer to the second position as this arrangement would provide the most obvious solution to conserve electrical power when the devices are not in use as taught by Murata.

Regarding claims 16, Cipolla further teaches the following: camera (1, fig. 10) has a housing that is completely disposed in the first position such that housing forms an exterior surface of the computer as shown fig. 10.

Regarding claims 18-19, Cipolla further teaches the following : computer (11, fig. 9) comprises a mounting member (57, fig. 10), wherein the mounting member is disposed inside the computer in the first position and extends outwardly from the

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computer in the second position, camera is mechanically connected to the mounting member while in the first position (fig. 10, col. 5, lines 49-66; col. 6 lines 11-50)

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cipolla in view of Murata as applied to claim 15 above, and further in view of Boyden.

The combination differs from claim 17 in that it does not teach the following: camera transmits wireless signals to the computer while in the second position.

However, Boyden discloses camera positioning system which teaches the following: wireless transmitter (440, fig. 4) wirelessly transmitting camera signals to a wireless receiver (432) for further use (paragraph: 0079).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: camera transmits wireless signals to the computer while in the second position as this arrangement would provide one of the methods, among many possible methods, for transmitting signals between the devices as taught by Boyden.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnishi in view of Yamane.

Regarding claim 10, Ohnishi teaches a method, comprising: ejecting the camera from inside the cavity located in a computer (100, figs. 1, 4-9) and inserting the camera into the cavity of the computer (this reads on expansion unit 200, fig. 1 and 400 figs. 6-9 which includes camera being stored in the expansion bay slot in base 20, fig. 1; col. 11 lines 39-40; col. 17 lines 7-12, col. 18 lines 30-35)

Ohnishi differs from claim 10 in that it does not teach the following: automatically powering a camera on/or off depending upon whether the camera is ejected/or inserted from/or in computer.

However, Yamane teaches the following: automatically powering a flash unit (4, figs. 1-4) on/or off depending upon whether the flash unit is ejected/or inserted from/or in electronic device (1, fig. 1, col. 4, line 43 – col. 5, line 34).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ohnishi's system to provide for the following: automatically powering a camera on/or off depending upon whether the camera is ejected/or inserted from/or in computer as this arrangement would facilitate to conserve power usage by turning on power to the device on/off depending upon its usage condition as taught by Yamane.

(10) Response to Argument

Claim Rejection: 35 U.S.C 112

As a first matter, Appellant misstates claim 15 is rejected under 35 U.S.C 112, second paragraph while in fact it is rejected 35 U.S.C 112 first paragraph.

Independent claim 15 recites, among other things, a camera movable between a first position and a second position, wherein the camera is enclosed inside the computer in the first position and is ejected to be mechanically detached from the computer in the second position, the camera being electrically coupled to the computer in the second position, wherein the camera is in a power-off state while enclosed inside the computer in the first position and automatically transitions to a power on state as the camera is

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ejected and physically moves from the first position to the second position being mechanically detached.

Appellants in an effort to explain 35 U.S.C 112 first paragraph rejection state that “Appellants strongly disagree. The specification clearly explain and show that a switch is used to transition from a power off state to a power-on state as camera is being ejected from the portable electronic device”, and quotes from the specification to support their case. Unfortunately Appellants are sidetracking the main issue here: that of camera which physically moves from the first position to the second position being mechanically detached. As stated in the final office action once camera is mechanically detached from the camera, it cannot automatically transitions to a power on state as the camera is ejected and mechanically separated. This is in fact the case as shown in fig. 7 where camera is mechanically detached and power is supplied to the camera by its rechargeable battery (paragraph: 0039 of Appellants Published Application US2005/01128284 A1). In view of this, Examiner respectfully submits to BPAI that Applicant has no disclosure to support limitations of claim 15 under 35 U.S.C 112 first paragraph and requests that rejection of claim 15 be upheld under 35 U.S.C 112 first paragraph as set forth in the final office action.

Claim Rejections 35 U.S.C 103(a)

Rejection of claims 1-4, 5-9, 11-13 under 35 U.S.C 103(a) as being obvious over Ohnishi et al. (US PAT: 6,525,932, filed 8-16-2000, hereinafter Ohnishi) in view of Yamane (US PAT: 6,285,833): Regarding rejection of these claims, Appellants states

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that claims 1-4, 5-9, 11-13 recite one or more elements that are not taught or suggested in Ohnishi in view of Yamane and lists the following arguments for the claims.

Sub-Heading: Independent Claim 1:

After reciting limitations of claim 1 and appellants interpretation of the references used in the rejection of claim 1, Appellants argue that "In contrast to Yamane, Claim 1 recites that the camera automatically powers on "as the camera is ejected from the base portion of the portable computer". The camera is not ejected from a base portion of a portable computer. Power to the camera in Yamane is not activated upon ejection of the camera. Instead, power to the camera in Yamane is activated when a pop-up flash on the camera when a pop-up flash on the camera is pushed". Regarding this, as set forth in the office action Ohnishi teaches: a camera (420, figs. 4-9, col. 17, line 13 – col. 18, line 12) stored in the base portion (this reads on expansion unit 200, fig. 1 and 400 figs. 6-9 which includes camera being stored in the expansion bay slot in base (20, fig. 1) of a portable computer when not in use (col. 11 lines 39-40; col. 17 lines 7-12, col. 18 lines 30-35). As stated further in the office action Ohnishi does not go into details as to how power is regulated to the camera between stored position (camera not in use) and ejected position (camera in use) although it would be inherent in Ohnishi system to apply power to the camera when in use (ejected position) and cut-off power to camera when not in use (stored position) in order to conserve power and prevent computer components subject to heat produced by camera components by leaving the camera powered on when not in use or stored in the computer body. However, Yamane discloses an arrangement in which flash unit (4, figs. 1-2) automatically powers

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on when ejected from the base portion, flash unit automatically powers off when inserted into the base portion (col. 3 lines 21-41; col. 4 lines 43-56; col. 5 lines 7-34).

Thus, using the teachings of Yamane, it would be obvious to one of ordinary skill in the art at the time invention was made to modify Ohnishi camera system to be powered on when in use (ejected position) and to be powered off when camera not in use (storage position) in order to conserve power used for powering devices such as camera and prevent computer components subject to heat produced by camera components by leaving the camera powered on when not in use or stored in the computer body.

Sub-Heading: Dependent Claim 2

Regarding rejection of dependent claim 2, Appellant argues that "Dependent claim 2 recites that camera automatically powers off when inserted in to the base portion. The examiner admits ... Appellants disagree". Appellant further argues that "in contrast to Yamane, claim 2 recites that the camera automatically powers off "when inserted into the base portion". The camera in Yamane is not inserted into a base portion of a portable computer. Power to the camera in Yamane ... power is deactivated when a pop-up flash on the camera itself is pushed". Regarding this, as explained in responding to appellant's arguments to claim 1 rejection, Ohnishi teaches camera being stored in base portion of computer when not in use and camera being ejected from the base portion when camera in use while not elaborating on how power is controlled to the camera between in use position (ejected from the base portion) and not in use position (storage position in the base portion) although it would be inherent in Ohnishi system to apply power to the camera when in use (ejected position) and cut-off

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power to camera when not in use (stored position) in order to conserve power, and prevent computer components subject to heat produced by camera components by leaving the camera powered on when not in use or stored in the computer body.

However, Yamane discloses an arrangement in which flash unit (4, figs. 1-2) automatically powers on when ejected from the base portion, flash unit automatically powers off when inserted into the base portion (col. 3 lines 21-41; col. 4 lines 43-56; col. 5 lines 7-34). Thus, using the teachings of Yamane, it would be obvious to one of ordinary skill in the art at the time invention was made to modify Ohnishi camera system to be powered off when camera not in use (storage position) in order to conserve power used for powering devices such as camera, and prevent computer components subject to heat produced by camera components by leaving the camera powered on when not in use or stored in the computer body.

Claim rejections: 35 U.S.C 103(a)

Rejection of claim 14 under 35 U.S.C 103(a) as being obvious over Ohnishi in view of Yamane as applied to claims 1, 9 above, and further in view of Boyden et al. (US 2003/0112325 A1, hereinafter Boyden): Regarding rejection of dependent claim 14, Appellants arguments are to tied to independent claim 1 being patentable which is not as explained above.

Claim rejections: 35 U.S.C 103(a)

Rejection of claims 15-18 under 35 U.S.C 103(a) as being obvious over Cipolla et al. (US PAT: 6,587,151, hereinafter Cipolla) in view of Murata et al. (US PAT: 5,691,766, hereinafter Murata): Regarding rejection of claims 15-18 using the above

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references, Applicant argues that claims 15-18 recite one or more elements that are not taught or suggested in Cipolla in view of Murata and further sets forth these arguments.

Sub-Heading: Independent claim 15

After reciting limitations of claim 15 and references applied in rejection of claim 15, Appellant argues that” in contrast to Murata, claim 15 recites that the camera is in power-off state while enclosed inside the computer in the first position and automatically transitions to a power-on state as the camera is ejected and moves from the first position inside the computer to the second position being mechanically detached from the computer. Importantly, the camera in Murata is not transitioning from power-off state to a power-on state. Instead, a built-in light transitions from the power-off to the power-on state. Furthermore, in Murata, the built-in light is moving, not the camera. Specifically ... By contrast, claim 15 recites that the camera (not a light in the camera) “physically moves from the first position inside the computer to the second position being mechanically detached from the computer. As yet a further difference, power to the camera in Murata is not activated. Instead, Murata is activating power to a built-in light, not the camera itself. In Murata, the camera is already on when the built-in light is activated”. Regarding this, Cipolla discloses video conference system (col. 1 lines 34-38), comprising: a computer (11, fig. 9), and a camera movable between a first position (stored position, fig. 10) and second position (usable position, fig. 9), wherein the camera is enclosed in the computer in the first position (fig. 10) and is ejected to be mechanically detached from the computer in the second position (fig. 9), the camera being electrically coupled to the computer in the second position (fig. 9; col. 5, lines 49-

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66; col. 6 lines 11-50). But Cipolla does not elaborate on power-on or power-off for camera between first position (stored position, fig. 10) and second position (usable position, fig. 9) although it would be inherent to control power-on to the camera when in second position (usable position, fig. 9) and power-off in the first position (stored position, fig. 10) in order to conserve power and prevent computer components subject to heat produced by camera components by leaving the camera powered on when not in use or stored in the computer body. However, Murata teaches the principle of controlling power to a device such as camera light being power-off state when enclosed in camera device in the first position and automatically transitions to a power on state as the camera light is ejected from the stowed position (fig. 9, col. 4 lines 25-38). Thus, by using teachings of Murata, one of ordinary skill in the art at the time invention was made to modify Cipolla's system where camera is in power-off state when enclosed in a computer in the first position and automatically transitions to power on state as the camera is ejected and physically moves from the first position in the computer to the second position when the devices are not in use as taught by Murata as this arrangement would provide the most obvious solution to conserve electrical power and prevent computer components subject to heat produced by camera components by leaving the camera powered on when not in use or stored in the computer body.

Claim rejections: 35 U.S.C 103(a)

Rejection of claim 17 under 35 U.S.C 103(a) as being obvious over Cipolla in view of Murata further in view of Boyden: Regarding rejection of dependent claim 17,

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Appellant's arguments are tied to dependent claim 17 being patentable which is not as explained above.

Claim rejections: 35 U.S.C 103(a)

Rejection of claim 10 under 35 U.S.C 103(a) as being obvious over Ohnishi in view of Yamane: regarding rejection of claim 10 using the above references, Appellant argues that claim 10 recites one or more elements that are not taught or suggested in Ohnishi in view of Yamane and sets forth his arguments on rejection of claim 10. For instance, Appellant argues that "claim 10 recites automatically powering a camera on while ejecting the camera from inside a cavity located in a computer, and automatically powering the camera off while inserting the camera into the cavity of the computer. Ohnishi in view of Yamane do not teach ... Yamane does not suggest automatically powering a camera on while powering a camera on while ejecting the camera from inside a cavity located in a computer or automatically powering the camera off while inserting the camera into the cavity of the computer". Regarding this, Ohnishi teaches a method, comprising: ejecting the camera from inside the cavity located in a computer (100, figs. 1, 4-9) and inserting the camera into the cavity of the computer (this reads on expansion unit 200, fig. 1 and 400 figs. 6-9 which includes camera being stored in the expansion bay slot in base 20, fig. 1; col. 11 lines 39-40; col. 17 lines 7-12, col. 18 lines 30-35). But Ohnishi does not elaborate on automatically powering a camera on/or off upon whether the camera is ejected/or inserted from/or cavity of computer although it would be inherent to power-on camera when ejected from the cavity of computer (use position) and power-off when camera is in cavity of computer (stored position) in order

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to not to waste power, and to prevent computer components subject to heat produced by camera components by leaving the camera powered on when not in use or stored in the computer body. However, Yamane discloses a arrangement for automatically powering a flash unit (4, figs. 1-4) on/off depending upon whether the flash unit is ejected/or inserted from/or in electronic device (1, fig. 1, col. 4, line 43 – col. 5, line 34). Thus, in light of teachings of Yamane, it would be obvious to one of ordinary skill in the art at the time invention was made to modify Ohnishi's system to automatically powering a camera on/or off upon whether the camera is ejected/or inserted from/or cavity of computer in order not to waste power unnecessarily and also prevent computer components from getting exposed to temperature raise by leaving the power on to the camera when not in use (i.e. stored in the cavity of computer).

Under the heading Factors/Rationale for claims obviousness Ohinishi in view of Yamane, Appellants present various arguments to dispute claim rejections. For instance, Appellants argue that "Appellants respectfully submit that no teaching or suggestion exists to make the combination because the references are directed to completely different inventions" and appellants further list reasons according to their lights. As already explained Ohnish discloses camera that can be stored in computer when not in use and can be ejected when it needs to be used. Although he does not elaborate on whether the camera is powered on when ejected from its storage (in use) in computer and powered off when stored in computer (not in use), it would be inherent to power-on camera when ejected from computer body for use and power off when not in use (i.e. stored in computer) in order to conserve power and also prevent computer

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components being subject to heating as a result of camera being powered on when not in use. For example Yamane teaches an arrangement in which camera flash light is powered on when ejected from the camera body and power-off when not in use (stored position). In light of Yamane teachings, it would be obvious to one of ordinary skill in the art at the time invention was made to modify Ohinishi's system to provide for power-on to camera when ejected from computer body for use and power off when not in use (i.e. stored in computer) in order to conserve power and also prevent computer components being subject to heating as a result of camera being powered on when not in use.

Appellants further argues that Ohinishi and Yamane would have to be greatly modified to arrive at the claimed invention and list various things about changes involved according to their lights. For example, Appellants contend that a user would still be required to push the flash on camera to activate or power-on the camera so on and so forth. Regarding this just as appellant's system would have button to eject camera from its storage position in computer body in order to bring it into use position, so is button in Yamane's system to be operated to eject flash from storage position when its power is applied to the flash and camera. Thus there are similarities between the Appellant's ejection of camera and power application, and Yamane's system of ejecting flash from its storage position for its use and power application when ejected from its storage position.

Appellants further alleges that "the Examiner is performing an improper piecemeal construction that uses hindsight to arrive at the claimed invention. In

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response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant further argues that there is no teaching or suggestion to make the combination because the references are directed to solving completely different problems and list various reasons according their lights. As examiner has already explained, In light of Yamane teachings, it would be obvious to one of ordinary skill in the art at the time invention was made to modify Ohinishi's system to provide for power-on to camera when ejected from computer body for use and power off when not in use (i.e. stored in computer) in order to conserve power and also prevent computer components being subject to heating as a result of camera being powered on when not in use.

Under the heading Factors/Rationale for claims obviousness Cipolla in view of Murata, Appellants present various arguments to dispute claim rejections. For instance, Appellants argue that "Appellants respectfully submit that no teaching or suggestion exists to make the combination because the references are directed to completely different inventions" and appellant further list reasons according to their lights. As already explained, Cipolla discloses video conference system (col. 1 lines 34-38),

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comprising: a computer (11, fig. 9), and a camera movable between a first position (stored position, fig. 10) and second position (usable position, fig. 9), wherein the camera is enclosed in the computer in the first position (fig. 10) and is ejected to be mechanically detached from the computer in the second position (fig. 9), the camera being electrically coupled to the computer in the second position (fig. 9; col. 5, lines 49-66; col. 6 lines 11-50). But Cipolla does not elaborate on power-on or power-off for camera between first position (stored position, fig. 10) and second position (usable position, fig. 9) although it would be inherent to control power-on to the camera when in second position (usable position, fig. 9) and power-off in the first position (stored position, fig. 10) in order to conserve power and also prevent computer components being subject temperature when camera is powered on in stored position (i.e. camera is not in use). However, Murata teaches the principle of controlling power to a device such as camera light being power-off state when enclosed in camera device in the first position and automatically transitions to a power on state as the camera light is ejected from the stowed position (fig. 9, col. 4 lines 25-38). Thus, by using teachings of Murata, one of ordinary skill in the art at the time invention was made would be motivated to modify Cipolla's system where camera is in power-off state when enclosed in a computer in the first position and automatically transitions to power on state as the camera is ejected and physically moves from the first position in the computer to the second position as this arrangement would provide the most obvious solution to conserve electrical power when the device is not in use, and also prevent computer

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components being subject to heating as a result of camera being powered on when not in use.

Appellants further argue that Cipolla and Murata would have to be greatly modified to arrive at the claimed invention and provide list of reasons according to their lights. For example, Appellants contend that a user would still be required to move the built in light on the camera to activate the light of the camera and so on and so forth. Regarding this just as appellant's system would involve user to move camera from its first position (stored position) to a second position (usable position), so is Murata system would involve user moving light between first position when it is stowed and second position when it is moved from stowed position and its power is applied. Thus there are similarities between the Appellant's camera moving between first position and second position and power application, and Murata's system of removing camera light from its stowed position for its use and power application when moved from stowed from its storage position.

Appellants further argue that "the examiner is performing an improper piecemeal construction that uses hindsight to arrive at the claim elements". In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only

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from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant further argue that there is no teaching or suggestion to make the combination as references are directed to solving completely different problems and list various reasons according their lights. As examiner has already explained In light of Murata's teachings, one of ordinary skill in the art at the time invention was made would be motivated to modify Cipolla's system where camera is in power-off state when enclosed in a computer in the first position and automatically transitions to power on state as the camera is ejected and physically moves from the first position in the computer to the second position as this arrangement would provide the most obvious solution to conserve electrical power when the devices are not in use, and also prevent computer components being subject to heating as a result of camera being powered on when not in use.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

Art Unit: 2614

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